

Doc Code: AP.PRE.REQ

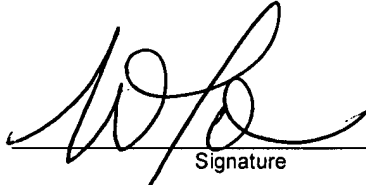
PTO/SB/33 (01-09)

Approved for use through 02/28/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) SON-3141 | |
|---|---|--------------------------------------|--|
| | Application Number 10/541,500-Conf. #2009 | Filed July 7, 2005 | |
| | First Named Inventor Yasutaka Ogasawara | | |
| | Art Unit 2446 | Examiner G. W. Li | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.</p> <p>Registration number <u>40,290</u> <u>24,104</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> _____ Signature Christopher M. Tobin Ronald P. Kananen _____ Typed or printed name</p> <p>_____ (202) 955-3750 Telephone number</p> <p>_____ April 29, 2009 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p> | | | |



Docket No.: SON-3141
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yasutaka OGASAWARA et al.

Application No.: 10/541,500

Confirmation No.: 2009

Filed: July 7, 2005

Art Unit: 2446

For: SERVICE MANAGING APPARATUS AND
METHOD, AND SERVICE PROVIDING
SYSTEM AND METHOD

Examiner: G. W. Li

REQUEST FOR PRE-APPEAL BRIEF PANEL REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This request for Pre-Appeal Panel Review is in response to the Final Office Action dated December 8, 2008 and received in this application. Applicant has concurrently filed a Notice of Appeal regarding all outstanding grounds of rejection and will file an Appeal Brief in due course. However, it is anticipated that Panel Review will obviate the need for the filing a Brief.

Claims 1, 3-4, 6-8, 10-11, 13-14, 16-17, 19-21, 23 and 25-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,266,649 to Linden et al. ("Linden") in view of U.S. Pat. No. 5,933,811 to Angles et al. ("Angles"), and further in view of U.S. Pub. No. 2004/0024652 to Buhse et al. ("Buhse"). This rejection is traversed.

Applicant's claimed invention accommodates the sending of digital content between communications devices that are connected to each other. That is, the digital content itself is selected and then received by one of the communication devices, with the digital content itself being

provided to that communication device from another of the communication devices (the information provider).

Claim 1 recites a service management apparatus that manages an information transmission service in which the digital content is sent in real time between the so-connected communication devices. Pursuant to this, an information registering means registers the digital content available from those of the communication devices that are registered as an information provider. The information managing means dynamically generates choices-window information for selection of a desired piece of offered digital content for the communication device that is to receive the desired piece of offered digital content. The communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider. Additionally, the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time. When, this is the case, the communication controlling means controls the connection so that the digital content can be provided in real time between the respective communication devices.

Linden fails to even basically address in any way controlling a connection between the respective communication devices so that the digital content can be provided from one communication device to the other. As such, there are also various claimed particular features in support of such digital content provision that are wholly absent from Linden. Linden discloses a system that allows for collaborative recommendations wherein computer users may rate various items that are available through the web site/server. The computer users do not register “digital content” that is to be provided by their computer, nor do they select from among the offered digital content so that it can be sent from one of the computers to another of the computers that may be connected through the network.

At best, one user of a “communication device” in Linden may post a recommendation about an item (e.g., a book, a chair, etc.) that is available from a separate service provider. The recommendation then appears when some other user navigates to a web page for the item. This is obviously not the provision of digital content nor is the recommendation the object of selection.

It is clearly erroneous to conclude that a recommendation is the provision of digital content, or controlling the same, as provided by one communication device to another communication device, as claimed by Applicant. The recommendation is merely posted to the server, and the server later conveys the recommendation to another user browsing available items. There is never an establishment of a connection between the communication devices, let alone in response to selection of content, or further in response to selection based upon indicated availability of the digital content from the communication device that is information provider in real time. With this degree of deficiency, it is clear that Linden has little or no pertinence to Applicant's claimed invention.

Still further, Linden does not disclose or suggest "*wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,*" or "*wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time,*" as claimed by Applicant.

Linden discloses generating recommendations that are specific to a shopping cart. (See 6:52-67 of Linden). This is not an example of registering a device as an information provider of digital content, or providing an indication that the corresponding digital content is available in real time, or of providing the desired piece of offered digital content in real time, from the registered communication device that is the information provider to the registered communication device that is to receive the digital content.

The Action seeks to address this deficiency by again repeating the reference to the recommendation of the user, and claiming that the server filters what is ultimately shown to the other user as being available. Again, this ignores the information provider and information recipient roles of the two communication devices. In no way does the recommendation of the product constitute "*wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,*" as claimed by Applicant. In Linden, the only analogous window-choices

would be the content available from the server. This is not an example of offered digital content, and “choices” are not presented in the claimed fashion. Moreover, real time provision of the digital content is not in any way addressed, let alone real time provision of the digital content from the communication device (rather than from the server as is the case in Linden).

Angles does not remedy the deficiencies of Linden. Angles discloses a system for delivering customized advertisements within interactive communication systems. When a user of a “consumer computer” accesses an offering from a content provider computer, a corresponding advertisement provider computer generates a custom advertisement based upon the user’s profile, and combines that custom advertisement with the offering being provided by the content provider computer for display by the consumer computer. There is no technical sense to the combination.

Additionally, although some “content” is arguably delivered from the advertisement provider computer to the consumer computer (*i.e.*, the customized ads, presumably within web pages or the like that are accessed through the content provider computer), as with the Linden reference there is clearly no disclosure or suggestion of the features of having choices-window information from which selection is made of a desired one of the plurality of pieces of offered digital content by those of the communication devices that are to receive the desired piece of offered digital content.” Even under the strained interpretation of this reference that appears to have been maintained by the Examiner in the Action, there is no reasonable instance of selection of the desired content in a choices window as claimed. Advertisements are merely pushed to users by inserting them into web pages, the advertisements are not selected from a menu or the like.

Also, the claims actually recite “*wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,*” and “*wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time,*” and that neither reference contains any disclosure whatsoever of these claimed features.

In addition to the above-noted inadequacies, the Action notes that the combination of Linden together with Angles still does not disclose maintaining registration information on more than one piece of digital content from registered communication devices, offered digital content in real time, and offered content being provided in real time when it is indicated as being offered in real time. (See Office Action, at p. 9).

Buhse remedies neither the deficiencies noted in the Action nor the additional deficiencies noted above regarding Linden and Angles. Buhse discloses a digital distribution platform that provides a common messaging system that is said to be flexible while at the same time providing digital rights management enforcement. Buhse clearly describes a system wherein a variety of devices communicate with the system to review and acquire content. There is no mention of the establishment of connections between separate communication devices of information providers and information recipients wherein the content is then provided from the information provider communication device to the communication device that is to receive the digital content. The available "digital products" are merely those available through the system, not from one communication device to the other as claimed.

Thus, since Linden, Angles, and Buhse, whether taken alone or in combination, fail to yield the claimed features recited in Applicant's claim 1, Applicant submits that a *prima facie* case of obviousness is not present for that claim (or independent claims 8, 14 and 21, or specific dependent claim features for reasons of record). Also, the introduction of the Cave reference regarding dependent claims 34-39 neither remedies the deficiencies of Linden, Angles, and Buhse, nor discloses the dependent claim features, also for reasons of record.

Reversal of all rejections of record and allowance of the application are solicited.

Dated: April 29, 2009

Respectfully submitted,

By 

Christopher M. Tobin

Registration No.: 40,290

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorneys for Applicant